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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,294	02/28/2002	Gary Paul Noble	GB920010066US1	7527

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SCULLY, SCOTT, MURPHY & PRESSNER, P.C.  
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GARDEN CITY, NJ 11530

EXAMINER
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CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/085,294

Applicant(s)

NOBLE, GARY PAUL

Examiner

Paul Callahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 29, 2007 has been entered.

2. Claims 1-18 are pending in this application have been examined.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-5, and 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subramaniam, International Application WO 01/59545 A3, and Boesch et al., US 5,870,473, and further in view of McLaughlin, International Application WO 00/01108 A3, and Young et al., 6,473,508.

As for claim 1, Subramaniam teaches a method for communication via a computer network (Abstract), the method comprising: registering a plurality of users with a trusted body (Detailed Description: page 2 paragraph 2); said trusted body verifying the identity of each user (Detailed Description: page 4 paragraph 1 and 5); the trusted body keeping a confidential record of the relation between the identity of each user and the random identifier for the user (Detailed Description: page 2 bottom paragraph: the web server is secure against unauthorized access, page 4 paragraph 7: the account info is stored with the user's assigned PIN); wherein one of the users can enter into a dialogue with one or more other users by means of messages sent over the computer network and through the trusted body to one or more other users (Abstract, Detailed Description page 3 paragraphs 5-7), and wherein a user remains anonymous through use of its identifier (Detailed Description page 4 paragraph 7: PIN) until such time as the user reveals its identity to one or more of the other users (Abstract, Detailed Description page 3 paragraph 7); and wherein the method includes recording the dialogue and using the recorded dialogue together with the confidential record of the relation between the identity of a user and the random identifier to provide a means of non-repudiation of the dialogue by users (Detailed Description: page 6 paragraph 2 posted messages are

stored on the web server, page 7 paragraph 8: transaction messages are posted and stored on the web server, page 8 paragraph 8, page 8 paragraph 9). Subramaniam does not explicitly teach generating a user identifier that is a random number for each user. However Boesch et al. does teach this feature (col. 35 lines 45-50). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Boesch into the system of Subramaniam. It would have been desirable to do so since generation of a PIN that is a random number would increase the security of the system of Subramaniam by making it more difficult for an unauthorized person to guess at a client's PIN. Additional motive to make this combination is found for example at the Detailed Description of Subramaniam: page 14 paragraph 5 where anonymity is taught as a major advantage of his system. A PIN that is a random number would enhance such. The combination of Boesch and Subramaniam do not teach the step of the trusted body encrypting each message of the dialog using a (second) public key of a public / private key pair of the trusted body. However McLaughlin does teach this step (page 10 lines 25-30, page 11 lines 9-10, page 13 lines 5-15). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the combination of Boesch and Subramaniam. It would have been desirable to do so since this would increase the security of the system and hence increase the likelihood of the trusted body being able to keep the identity of a user confidential. Motive to make this combination is found for example, in the abstract and page 1 lines 1-5 of Subramaniam where user anonymity is stated as a desirable goal for his invention. The combination of Subramanian, Boesch,

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and McLaughlin fail to teach a step of a user generating a public / private key pair, and sending the public key of the pair to a trusted body that uses the public key to verify the identity of a user. However Young does teach this step, (fig. 1, fig. 4, col. 9 lines 21-35, where the public key is used to verify communication with an escrow agent). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the combination of Subramaniam, Boesch, and McLaughlin. It would have been desirable to do so since such a subscriber authentication routine would increase the security of the communications and would do so using a well-established protocol.

As for claim 3, Subramaniam teaches a method as claimed in claim 1, wherein the trusted body verifies the suitability of a user to participate in a dialogue (Detailed Description page 9 paragraph 7, 14 paragraph 4: users are prompted to log in to the system, i.e. be authenticated, prior to posting messages. Without login, users can only browse a public message board).

As for claim 4, Subramaniam teaches the method as claimed in claim 1, but not an additional step wherein the trusted body verifies the authenticity of a message sent by a user. However Boesch does teach such a step (col. 15 lines 49-57). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Subramaniam. It would have been desirable

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since this would make it more difficult for an unauthorized person to gain unauthorized access to the system.

As for claim 5, the combination of Subramaniam and Boesch teach a method as claimed in claim 4, but not one wherein the trusted body uses public key cryptography to authenticate messages sent by a user. However Official Notice may be taken that the use of such a step is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the system of Subramaniam and Boesch. It would have been desirable to do so since this would increase the security of the system by making it more difficult for an unauthorized person to gain unauthorized access to a user's account.

As for claim 7, Subramaniam teaches a method as claimed in claim 1, wherein the dialogue is in real time (Detailed Description page 9 paragraph 5, the system notifies a recipient in real-time that a message has been posted to them).

As for claim 8, Subramaniam teaches a method as claimed in claim 1, wherein the trusted body prescribes a set of rules to be followed by the users (Detailed Description page 9, final paragraph, the privacy agent enforces a rule against disclosure of the user's personal information to the "public" side of the bulletin boards).

As for claim 9, Subramaniam teaches a method as claimed in claim 1, wherein, the users can be any of: individuals, corporate bodies, organizations, automated machines or software applications (Abstract: individual user's are taught).

As for claim 10, Subramaniam teaches a method as claimed in claim 1, wherein a message from a user is sent to an input queue to ensure the correct order of the messages handled by the trusted body (Detailed Description page 6 paragraph 2).

As for claim 11, Subramaniam teaches a method as claimed in claim 1, wherein messages can include attachments in the form of documents to be discussed in the dialogue between users (Detailed description page 9 paragraph 6).

As for claim 12, the combination Subramaniam and Boesch teaches a method as claimed in claim 11, but not one wherein the attachments are signed or watermarked. However Official Notice may be taken that the implementation of such a step is one that is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the system of Subramaniam and Boesch. It would have been desirable to do so since this would increase the security of the system by making it more difficult for an unauthorized person to alter a visual or other depiction of an item being sold to the disadvantage of the seller.

As for claim 13, the claim is directed towards the system that carries out the method of claim 1 and it contains substantially the same limitations as claim 1. Therefore claim 13 is rejected on the same basis as claim 1.

As for claim 14, Subramaniam teaches a system as claimed in claim 13, wherein the computer network is the Internet and the trusted body is an Internet service provider (Abstract, Background of the Invention: instant messaging service).

As for claim 15, Subramaniam teaches a system as claimed in claim 13, wherein each user has a graphical user interface showing the dialogue and status of the other users (Detailed Description page 2 second to last paragraph: users interact through accessing a web portal, therefore a GUI is inherent to the system).

As for claim 16, Subramaniam teaches a system as claimed in claim 15, wherein the graphical user interface includes a means for viewing a document sent by a user as an attachment to a message of the dialogue (Detailed Description page 3 paragraph 4).

As for claim 17, the claim is directed towards the computer program, embodied in a memory medium, that when read out causes the apparatus of claim 13 to carry out the method of claim 1. The claim has substantially the same limitations as claim 1 and is therefore rejected on the same basis.

As for Claim 18, the combination of Boesch and Subramaniam fail to explicitly teach the trusted body keeping the private key of a public private key pair. However McLaughlin does teach this step (page 10 lines 25-30, page 11 lines 9-10, page 13 lines 5-15: The trusted body decrypts the data encrypted under its public key, by definition it must do so with its private key). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the combination of Boesch and Subramaniam. It would have been desirable to do so since this would increase the security of the system and hence increase the likelihood of the trusted body being able to keep the identity of a user confidential. Motive to make this combination is found for example, in the abstract and page 1 lines 1-5 of Subramaniam where user anonymity is stated as a desirable goal for his invention.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Subramaniam and Boesch as applied to claim 1 above, and further in view of McLaughlin, International Application WO 00/01108 A3.

The combination of Subramaniam and Boesch teaches the method presented in claim 1, but not with the additional step of verifying the identity of a user by validating a public key certificate for a user. However, McLaughlin does teach this feature (Specification page 11 paragraph 2). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Subramaniam and Boesch. It would have been desirable to do so since authentication by public key certificate would increase the security of the system of

Subramaniam by making it more difficult for an unauthorized person to guess at a client's login data. Additional motive to make this combination is found for example at the Detailed Description of Subramaniam: page 14 paragraph 5 where anonymity is taught as a major advantage of his system. Such would be enhanced by use of a public key certificate for login since, in the case of McLaughlin, the web server creates it for the user and it need not contain any user-identifiable data.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Subramaniam and Boesch as applied to claim 1 above, and further in view of Walker et al., US 5,794,207.

The combination of Subramaniam and Boesch teach a method as claimed in claim 1, but not one wherein the trusted body time-stamps all messages from users when recording the dialogue formed by the messages between users. However Walker does teach this step (figure 7, col. 9 lines 19-21). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Subramaniam and Boesch. It would be desirable to do so since this would offer the user the ability to prove the time at which an offer to buy or sell was posted.

**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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SUPERVISORY PATENT EXAMINER